

REMARKS

This application is a continuation-in-part of U.S. 6,431,874. This is noted on the application as filed. It appears, however, that the Office staff failed to properly apprise the Examiner of the priority date, because the priority date renders unsustainable all rejections raised in the 17 April 2003 OFFICE ACTION.

The Specification Amendment

To obtain the benefit of the parent application's 25 Oct. 1999 filing date, 35 U.S.C. § 120 requires :

- (A) The parent application and this application share at least one common inventor;
- (B) This application must have been filed before the patenting of the parent application; and
- (C) This application must be amended to contain a specific reference to the parent application.

In the immediate case:

- (A) the parent and this application share their sole inventor;
- (B) this application was filed on Dec. 17th, 2001 - well before the Aug. 13th, 2002 patenting of the parent; and
- (C) the UTILITY PATENT APPLICATION TRANSMITTAL FORM for this application contains at ¶ 18 a specific reference to the parent patent application, and this AMENDMENT adds to the SPECIFICATION a specific reference to the parent.

Accordingly, this application is entitled to the 25 Oct. 1999 filing date of the parent application.

FERRY Does Not Qualify As Prior Art

This application claims a priority date of Oct. 25th, 1999; thus, to qualify as "prior" art, a reference must have been published not later than Oct. 25th, 1998. "Nicotine Dependence" by Linda H. FERRY therefore does not qualify as prior art.

At page 13, FERRY recites a 1998 copyright year. FERRY does not, however, recite a specific publication date (during nor after 1998). The publication date must have been after

September 9th, 1998, because at page 2 (Section I.A.), FERRY discusses a study of California smoking rates published on September 9th, 1998.¹ FERRY, then, must have been published sometime after September 9th.

Whether FERRY was published before or after the October 25th cut-off for "prior" art, however, is not shown in the evidence of record. Because FERRY does not include a publication date (or retrieval date) before Oct. 25th, FERRY cannot qualify as prior art. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2128 ("Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art.").

Because FERRY does not qualify as prior art, every rejection relying on FERRY must be withdrawn as a matter of law.² *See* MANUAL OF PATENT EXAMINING PROCEDURE § 715.02 ("Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date.").

Therefore, all rejections based on FERRY must be withdrawn as a matter of law. In addition, the obviousness rejections must be withdrawn because the OFFICE ACTION fails to plead a *prima facie* case of obviousness. This is because the art of record fails to suggest the

¹ FERRY cites John P. PIERCE *et al.*, "Has the California Tobacco Control Program Reduced Smoking?", 280 JOURN. AMER. MED. ASSOC. 893 (1998). That article is shown in the TABLE OF CONTENTS for the September 9, 1998 issue of JAMA (copy enclosed). Thus, FERRY cannot have been published before September 9th.

FERRY also notes, at VIII.A., that "Nicotine vapor inhalers (puffers) were introduced in August of 1998. Short-term success with oral inhaler in COPD patients is higher in pilot testing." This indicates FERRY was written long enough after the August, 1998 introduction of puffers to have evaluated puffers' "short-term success."

² The OFFICE ACTION relies on FERRY to show that the claim element of "hypnosis" was known in the prior art. While FERRY fails to qualify as prior art, the SPECIFICATION itself expressly says that hypnosis was known in the prior art. This is supported in prior art of record in the parent case, which shows hypnosis. *See e.g.*, Thomas J. GARY, "Some People Believe Hypnosis Is a Theatrical Stage Trick," (Gary Method publ., New York City) (undated); Thomas GARY, "The Guaranteed Gary Method..." (Val-Pak National Sales, publ. 1991); Thomas GARY, "Get the Most From the Gary Method," etc., cassette tapes (labels only) (Thomas Gary, New York City publ., 1988-90).

combining the references - to the contrary, certain references explicitly teach away from the combination.

The Prior Art Fails To Suggest The Claimed Combination

A *prima facie* case of obviousness requires that some document of record (either the reference cited, or another reference showing the level of skill in the art) teach a motivation to combine the various claim elements. This means, some reference must somewhere say, “combine FERRY with HAPWORTH.”

The Federal Circuit recently discussed this in In re LEE, docket no. 00-1158 (Fed.Cir., Jan. 18, 2002) (copy enclosed). In Lee, neither the Examiner nor the Board pointed to “any specific hint or suggestion in a particular reference” to combine the references. The Federal Circuit reversed.

The Federal Circuit, citing In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992), said “the examiner can satisfy the burden of showing the obviousness of the combination ‘only by showing some objective teaching in the prior art’.” (emphasis added). This is because the “factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” Id. Therefore, obviousness requires that “a particular reference” have some “specific suggestion” to combine the references.

In the immediate case, the OFFICE ACTION does not identify any “specific suggestion” in any “particular reference” which says, “combine FERRY with HAPWORTH.” To the contrary, the OFFICE ACTION says it would have been obvious to combine FERRY with HAPWORTH “for the purpose of training the subconscious mind of the user to learn to stop smoking.” Similarly, the OFFICE ACTION says it would be obvious to (1) combine UMBDENSTOCK “for the purpose of supplying needed nutrients to the user,” OFFICE ACTION at ¶ 3; (2) combine GAWIN “for the purpose of reducing tension and anxiety in the user,” OFFICE ACTION at ¶ 4; and (3) combine CARY “for the purpose of blocking physiologic, behavioral and reinforcing effects of nicotine,” OFFICE ACTION at ¶ 5.

These assertions are each statements of the *Examiner's* purpose in combining the references. None of these purposes are stated in any particular reference. No particular reference states any particular suggestion to combine.³ Because these suggestions to combine are provided by the Examiner, rather than by any specific part of any specific reference, these suggestions fail to support a *prima facie* case of obviousness as a matter of law.

The Art of Record

The parent of the immediate application is currently undergoing reissue / reexamination. As part of those proceedings, Applicant has submitted to the PTO a rather voluminous collection of art (both prior art and non-prior art). The Examiner is respectfully reminded that he needs to review the art of record in that related case and, if any of that art is believed to be relevant, to make it of record here. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2001.06(b) ("Normally, if the application under examination is identified as a continuation or continuation-in-part of an earlier application, the examiner will consider the prior art cited in the earlier application. The examiner must indicate in the first Office Action whether the prior art in a related earlier application has been reviewed. Accordingly, no separate citation of the same prior art need be made in the later application.").

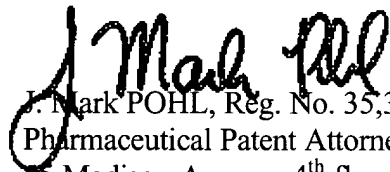
³ Furthermore, not only does UMBDENSTOCK fail to suggest combining the references, he expressly teaches away from it. Each reference must be considered as a whole, including portions which lead away from the claimed invention. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Here, UMBDENSTOCK discusses treating various different addictions. He notes that "[t]he nutritional supplement of the subject invention should be different for each addiction." UMBDENSTOCK at col. 9, lines 23-25. He then discusses different products for smoking cessation, for alcohol treatment, and for food addictions. UMBDENSTOCK teaches that kava kava and gotu kola should be used for food addictions - not smoking cessation.

Serial No.:10/023,254
Inventor: Alex. G. SZYNALSKI
Title: Stop Smoking Methods and Compositions
Group Art: 3712
Examiner: Kurt FERNSTROM, Esq.

Summary

Reconsideration is respectfully requested because the rejections must be withdrawn as a matter of law.

Respectfully submitted,


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Enclosures

In re LEE, Docket No. 00- 1158 (Fed. Cir., 18 Jan. 2002)
JOURNAL OF THE AMERICAN MEDICAL ASSOCIATION, vol. 280, No. 10 (9 Sept. 1998) -
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United States Court of Appeals for the Federal Circuit

00-1158
(Serial No. 07/631,240)

IN RE SANG SU LEE

Richard H. Stern, of Washington, DC, argued for Sang Su Lee. With him on the brief was Robert E. Bushnell.

Sidney O. Johnson, Jr., Associate Solicitor, of Arlington, Virginia, argued for the Director of the U.S. Patent and Trademark Office. With him on the brief were John M. Whealan, Solicitor, and Raymond T. Chen, Associate Solicitor. Of counsel were Maximilian R. Peterson and Mark Nagumo, Associate Solicitors.

Appealed from: Patent & Trademark Office
 Board of Patent Appeals and Interferences

United States Court of Appeals for the Federal Circuit

00-1158
(Serial No. 07/631,240)

IN RE SANG-SU LEE

DECIDED: January 18, 2002

Before NEWMAN, CLEVINGER, and DYK, Circuit Judges.

NEWMAN, Circuit Judge.

Sang-Su Lee appeals the decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, rejecting all of the claims of Lee's patent application Serial No. 07/631,210 entitled "Self-Diagnosis and Sequential-Display Method of Every Function."^[1] We vacate the Board's decision for failure to meet the adjudicative standards for review under the Administrative Procedure Act, and remand for further proceedings.

The Prosecution Record

Mr. Lee's patent application is directed to a method of automatically displaying the functions of a video display device and demonstrating how to select and adjust the functions in order to facilitate response by the user. The display and demonstration are achieved using computer-managed electronics, including pulse-width modulation and auto-fine-tuning pulses, in accordance with procedures described in the specification. Claim 10 is representative:

10. A method for automatically displaying functions of a video display device, comprising:
 - determining if a demonstration mode is selected;
 - if said demonstration mode is selected, automatically entering a picture adjustment mode having a picture menu screen displaying a list of a plurality of picture functions; and

automatically demonstrating selection and adjustment of individual ones of said plurality of picture functions.

The examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the Nortrup display does not include a demonstration of how to adjust the functions. The Thunderchopper Handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game; however, the Thunderchopper Handbook makes no mention of the adjustment of picture or audio functions. The examiner held that it would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system.

Lee appealed to the Board, arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated:

The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Board op. at 7. The Board did not explain the "common knowledge and common sense" on which it relied for its conclusion that "the combined teachings of Nortrup and Thunderchopper would have suggested the claimed invention to those of ordinary skill in the art."

Lee filed a request for reconsideration, to which the Board responded after five years. The Board reaffirmed its decision, stating that the Thunderchopper Handbook was "analogous art" because it was "from the same field of endeavor" as the Lee invention, and that the field of video games was "reasonably pertinent" to the problem of adjusting display functions because the Thunderchopper Handbook showed video demonstrations of the "features" of the game. On the matter of motivation to combine the Nortrup and Thunderchopper references, the Board stated that "we maintain the position that we stated in our prior decision" and that the Examiner's Answer provided "a well reasoned discussion of why there is sufficient motivation to combine the references." The Board did not state the examiner's reasoning, and review of the Examiner's Answer reveals that the examiner merely stated that both the Nortrup function menu and the Thunderchopper demonstration mode are program features

and that the Thunderchopper mode "is user-friendly" and it functions as a tutorial, and that it would have been obvious to combine them.

Lee had pressed the examiner during prosecution for some teaching, suggestion, or motivation in the prior art to select and combine the references that were relied on to show obviousness. The Examiner's Answer before the Board, plus a Supplemental Answer, stated that the combination of Thunderchopper with Nortrup "would have been obvious to one of ordinary skill in the art since the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software," and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial." The Board adopted the examiner's answer, stating "the examiner has provided a well reasoned discussion of these references and how the combination of these references meets the claim limitations." However, perhaps recognizing that the examiner had provided insufficient justification to support combining the Nortrup and Thunderchopper references, the Board held, as stated supra, that a "specific hint or suggestion" of motivation to combine was not required.

This appeal followed.

Judicial Review

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

5 U.S.C. §706(2) The reviewing court shall—

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the

found facts. The Court has often explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decisionmaking." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 374 (1998) (citation omitted). This standard requires that the agency not only have reached a sound decision, but have articulated the reasons for that decision. The reviewing court is thus enabled to perform meaningful review within the strictures of the APA, for the court will have a basis on which to determine "whether the decision was based on the relevant factors and whether there has been a clear error of judgment." Citizens to Preserve Overton Park v. Volpe, 401 U.S. 402, 416 (1971). Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (review is on the administrative record); In re Gartside, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000) (Board decision "must be justified within the four corners of the record").

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or

motivation to combine the prior art references is an 'essential component of an obviousness holding') (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether

a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting Burlington Truck Lines v. United States, 371 U.S. 156, 168 (1962)); Securities & Exchange Comm'n v. Chenery Corp., 318 U.S. 80, 94 (1943) ("The orderly function of the process of review requires that the grounds upon which the administrative agency acted are clearly disclosed and adequately sustained.").

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See Motor Vehicle Manufacturers, 463 U.S. at 43 ("an agency rule would be arbitrary and capricious if the agency . . . entirely failed to consider an important aspect of the problem"); Mullins v. Department of Energy, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action."). As discussed in National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp., 817 F.2d 74, 75 (9th Cir. 1987), an agency is "not free to refuse to follow circuit precedent."

The foundation of the principle of judicial deference to the rulings of agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency's application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See Baltimore and Ohio R. R. Co. v. Aberdeen & Rockfish R. R. Co., 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would

become lost "in the haze of so-called expertise"). The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See Allentown Mack, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle")

The case on which the Board relies for its departure from precedent, In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act

from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Alternative Grounds

At oral argument the PTO Solicitor proposed alternative grounds on which this court might affirm the Board's decision. However, as stated in Burlington Truck Lines, Inc. v. United States, 371 U.S. 156, 168 (1962), "courts may not accept appellate counsel's post hoc rationalization for agency action." Consideration by the appellate tribunal of new agency justifications deprives the aggrieved party of a fair opportunity to support its position; thus review of an administrative decision must be made on the grounds relied on by the agency. "If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis." Securities & Exchange Comm'n v. Chenery Corp., 332 U.S. 194, 196 (1947). As reiterated in Federal Election Comm'n v. Akins, 524 U.S. 11, 25 (1998), "If a reviewing court agrees that the agency misinterpreted the law, it will set aside the agency's action and remand the case – even though the agency (like a new jury after a mistrial) might later, in the exercise of its lawful discretion, reach the same result for a different reason." Thus we decline to consider alternative grounds that might support the Board's decision.

Further Proceedings

Sound administrative procedure requires that the agency apply the law in accordance with statute and precedent. The agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action. In Radio-Television News Directors Ass'n v. FCC, 184 F.3d 872 (D.C. Cir. 1999) the court discussed the "fine line between agency reasoning that is 'so crippled as to be unlawful' and action that is potentially lawful but insufficiently or inappropriately explained," quoting from Checkosky v. Securities & Exch. Comm'n, 23 F.3d 452, 464 (D.C. Cir. 1994); the court explained that "[i]n the former circumstance, the court's practice is to vacate the agency's order, while in the latter the court frequently remands for further explanation (including discussion of the relevant factors and precedents) while withholding judgment on the lawfulness of the agency's proposed action." Id. at 888. In this case the Board's analysis of the Lee

invention does not comport with either the legal requirements for determination of obviousness or with the requirements of the Administrative Procedure Act that the agency tribunal set forth the findings and explanations needed for "reasoned decisionmaking." Remand for these purposes is required. See Overton Park, 401 U.S. at 420-221 (remanding for further proceedings appropriate to the administrative process).

VACATED AND REMANDED

^[1] Ex parte Lee, No. 1994-1989 (Bd. Pat. App. & Int. Aug. 30, 1994; on reconsid'n Sept. 29, 1999).

JAMA

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Vol. 280 No. 10, pp. 863-944, September 9, 1998

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JAMA. 1998;280:863.

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ORIGINAL CONTRIBUTIONS

☐ Oral Famciclovir for the Suppression of Recurrent Genital Herpes: A Randomized Controlled Trial

Francisco Diaz-Mitoma; R. Gary Sibbald; Stephen D. Shafran; Ron Boon; Robin L. Saltzman; for the Collaborative Famciclovir Genital Herpes Research Group

JAMA. 1998;280:887-892.

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☐ Has the California Tobacco Control Program Reduced Smoking?

John P. Pierce; Elizabeth A. Gilpin; Sherry L. Emery; Martha M. White; Brad Rosbrook; Charles C. Berry

JAMA. 1998;280:893-899.

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☐ Physicians' Experiences and Beliefs Regarding Informal Consultation

Nancy L. Keating; Alan M. Zaslavsky; John Z. Ayanian

JAMA. 1998;280:900-904.

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☐ Curbside Consultation Practices and Attitudes Among Primary Care Physicians and Medical Subspecialists

David Kuo; David R. Gifford; Michael D. Stein

JAMA. 1998;280:905-909.

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CLINICAL CARDIOLOGY

☐ Exercise Echocardiography or Exercise SPECT Imaging?: A Meta-analysis of Diagnostic Test Performance

Kirsten E. Fleischmann; Maria G. M. Hunink; Karen M. Kuntz; Pamela S. Douglas

JAMA. 1998;280:913-920.

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BRIEF REPORTS

☐ Increased Cancer Mortality Following a History of Nonmelanoma Skin Cancer

Henry S. Kahn; Lilith M. Tatham; Alpa V. Patel; Michael J. Thun; Clark W. Heath, Jr

JAMA. 1998;280:910-912.

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CARING FOR THE UNINSURED AND UNDERINSURED

☐ Ability to Obtain Medical Care for the Uninsured: How Much Does It Vary Across Communities?

Peter J. Cunningham; Peter Kemper

JAMA. 1998;280:921-927.

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Phil Gunby
JAMA. 1998;280:870-871.
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First "Antisense" Drug Will Treat CMV Retinitis

Charles Marwick
JAMA. 1998;280:871.
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New Survival Advantage

Rebecca Voelker
JAMA. 1998;280:873.
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